REMARKS

Applicants file concurrently herewith a Request for Continued Examination (RCE) in response to the Notice of Panel Decision mailed March 3, 2008 and further to the Notice of Appeal filed February 1, 2008. Both the Notice of Panel Decision and the Notice of Appeal followed the Final Office Action mailed November 1, 2007 (hereinafter, "Office Action").

In the Office Action, the Examiner rejected claims 1-9, 12-16, and 18-26 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,483,049 to Schulze, Jr. et al. (hereinafter, "*Schulze*"); and rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Schulze*.

By this response, Applicants have amended claims 1-7 and 9-26. No new matter has been added. Accordingly, claims 1-26 remain pending.

In light of the foregoing amendments and based on the remarks presented below, Applicants respectfully traverse the rejections of the claims under 35 U.S.C. §§ 102(b) and 103(a), and request the allowance of pending claims 1-26.

I. Rejections Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-9, 12-16, and 18-26 under 35 U.S.C. § 102(b) as being anticipated by *Schulze*. "A proper anticipation rejection requires that "each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *M.P.E.P.* § 2131. In addition, "[t]he elements must be arranged as required by the claim . . . ." *Id.* (emphasis added). Applicants respectfully submit that *Schulze* fails to disclose all of

the subject matter recited in independent claims 1, 13, 18, and 22, and also fails to disclose the elements as arranged by the independent claims.

Schulze is directed towards "a system for facilitating the **generation, redemption and exchange of coupons** whereby the invention is useful as an intermediary between coupon distributors, retailers and consumers." *Schulze*, col. 1, ll. 5-8 (emphasis added). In the *Schulze* system, "a consumer inserts, for example, a conventional coupon 36 obtained from a newspaper into input slot 78a of coupon input unit 76a and subsequently a coupon exchange coupon 40 is output . . . ." *Id.* at col. 5, ll. 21-25. "The coupon exchange coupon 40 includes a cash rebate amount 900, an expiration date 904, a product description 908 describing the product for which the coupon applies . . . [and] any game and/or bonus prize area 920 that may be provided on coupon 40." *Id.* at col. 5, ll. 45-54 (emphasis added). "Once all products for a consumer transaction have been scanned by the product bar code scanner 56 (FIG. 1), and all coupon exchange coupons 40 for this transaction have been entered . . . then an operator interacts with an operator interface unit 256 for initiating the activation of a program to determine the amount of each check 48 to be printed and presented to the consumer." *Id.* at col. 9, ll. 57-63.

A. Claims 1-9 and 22-26

Schulze fails to teach, *inter alia*, "analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that considers at least one factor associated with each merchant in the group of merchants" and "identifying one

merchant of the group of merchants for associating with partnership checks based on the analysis," as recited in independent claim 1.

Instead, *Schulze* is directed towards "a system for facilitating the generation, redemption and exchange of coupons . . . ." *Schulze*, col. 1, ll. 5-8 (emphasis added). *Schulze* discloses that "[i]n the preferred embodiment, the coupon exchange coupons are only valid at the retail sales store in which they are issued . . . ." *Schulze* at col. 2, ll. 65-67 (emphasis added). Thus, in this embodiment, *Schulze* does not disclose "analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that considers at least one factor associated with each merchant in the group of merchants" and "identifying one merchant of the group of merchants for associating with partnership checks based on the analysis," as recited in independent claim 1. Instead, *Schulze* discloses that the coupon exchange coupons are only valid with *a single merchant* -- the one in which the coupon exchange coupons are issued.

Schulze also states that "since the coupon exchange coupon 32 can be encoded such that they are valid for only predetermined business locations, a manufacturer or service provider can easily limit the exchange of coupon exchange coupons 40 to, for example, retail outlets in a particular geographical region." *Id.* at col. 18, ll. 34-39 (emphasis added). This, however, does not disclose "analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that considers at least one factor associated with each merchant in the group of merchants" and "identifying one merchant of the group of merchants for associating

with partnership checks based on the analysis," as recited in independent claim 1. Rather, *Schulze* encodes the coupon exchange coupons so that they are valid for an unspecified number of predetermined business locations in a particular geographic region.

Furthermore, the coupon exchange coupons disclosed by *Schulze* are provided to a single user and not sent "to a set of customers . . . ," as further recited in amended independent claim 1.

Accordingly, for at least the above-outlined reasons, *Schulze* fails to disclose all of the subject matter recited in Applicants' amended independent claim 1. Therefore, the rejection of independent claim 1 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claim 22, although of different scope, recites elements similar to those of independent claim 1, and is therefore allowable for at least the same reasons. Therefore, the rejection of independent claim 22 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claims 2-9 depend from independent claim 1, and claims 23-26 depend from independent claim 22. As discussed above, *Schulze* does not support a rejection of independent claims 1 and 22. Therefore, dependent claims 2-9 and 23-26 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claims.

B. Claims 13-16

With respect to amended independent claim 13, *Schulze* fails to teach, *inter alia*, "forming a value sharing relationship between the issuer and at least one merchant, wherein the value sharing relationship allows the issuer and the at least one merchant to share the value provided by use or issuance of at least one of the partnership checks" and "generating partnership checks that are redeemable with the at least one merchant, each of the partnership checks including printed indicia that is indicative of a predetermined transaction amount, an account number associated with a respective customer in the set of customers, and a routing number." Instead, *Schulze* discloses that the "coupon redemption system of the present invention is useful in performing an intermediary role between coupon distributors, retailers and consumers." *Id.* at col. 1, ll. 65-67 (emphasis added). In its role as intermediary, the coupon redemption system serves to "allow a retailer of the product or service to redeem the coupon exchange coupons 40 without using the retailer's funds." *Id.* at col. 18, ll. 28-30.

Schulze discloses a merchant that "redeem[s] the coupon exchange coupons 40 without using the retailer's funds." *Id.* at col. 18, ll. 28-30 (emphasis added). However, *Schulze* does not disclose "forming a value sharing relationship between the issuer and at least one merchant, wherein the value sharing relationship allows the issuer and the at least one merchant to share the value provided by use or issuance of at least one of the partnership checks" and "generating partnership checks that are redeemable with the at least one merchant, each of the partnership checks including printed indicia that is indicative of a predetermined transaction amount, an account

number associated with a respective customer in the set of customers, and a routing number," as recited in Applicants' amended independent claim 13.

For example, *Schulze* discloses "[o]nce all products for a consumer transaction have been scanned by the product bar code scanner 56 (FIG. 1), and all coupon exchange coupons 40 for this transaction have been entered . . . then an operator interacts with an operator interface unit 256 for initiating the activation of a program to determine the amount of each check 48 to be printed and presented to the consumer." *Id.* at col. 9, ll. 57-63. "[I]t is noteworthy as an important aspect of the present invention that the checks 48 do not have the retail sales store 24 as the payor. Instead, the checks 48 are drawn on an account specific to the enterprise operating the coupon exchange system 20." *Id.* at col. 10, ll. 18-22. Thus, *Schulze* merely relieves the retailer from the "substantial delay between the acceptance of coupons for redemption and when the retailer is compensated for the coupons accepted" and the "cost overhead in handling redeemed coupons incurred by the retailer," shifting these burdens instead to the enterprise operating the coupon exchange system. *Id.* at col. 1, ll. 41-47.

Accordingly, for at least the above-outlined reasons, *Schulze* fails to disclose all of the subject matter recited in Applicants' amended independent claim 13. Therefore, the rejection of independent claim 13 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claims 14-16 depend from independent claim 13. As discussed above, *Schulze* does not support a rejection of independent claim 13. Therefore, dependent

claims 14-16 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claim.

C. Claims 18-21

Schulze fails to disclose, *inter alia*, "generating a list of prospective merchants," "analyzing the list of prospective merchants based on a set of merchant qualification criteria to form a set of merchants," "generating a list of prospective customers," "analyzing the list of prospective customers based on a set of customer qualification criteria to form a set of customers" and "generating partnership checks, wherein each of the partnership checks includes an account number associated with a respective customer in the set of customers and a routing number," as recited in amended independent claim 18.

First, the Examiner admits that *Schulze* fails to teach "generating a list of prospective merchants," and instead alleges that "'generating a list of prospective merchants' is inherent." Office Action at p. 3. However, the Office Action fails to provide a basis in fact or technical reasoning to support an inherency determination. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

To show inherency, the Examiner must provide rationale or evidence to support the assertion that a recitation is inherent. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d

1949, 1950-51 (Fed. Cir. 1999); *See also M.P.E.P.* § 2112. In this case, the Examiner has not provided any rationale or evidence to support the position that generating a list of prospective merchants is inherent. Indeed, *Schulze* does not generate a list of prospective merchants and thus cannot support the rejection of claim 18. Accordingly, the rejection of claim 18 is legally deficient.

Furthermore, *Schulze* fails to disclose "analyzing the list of prospective merchants based on a set of merchant qualification criteria to form a set of merchants," "generating a list of prospective customers," "analyzing the list of prospective customers based on a set of customer qualification criteria to form a set of customers" and "generating partnership checks, wherein each of the partnership checks includes an account number associated with a respective customer in the set of customers and a routing number," as recited in amended independent claim 18.

Instead, as discussed above in connection with amended independent claim 1, *Schulze* discloses either that the coupon exchange coupons are only valid with *a single merchant* -- the one in which the coupon exchange coupons are issued, or the coupon exchange coupons are encoded so that they are valid for an unspecified number of predetermined business locations in a particular geographic region. *See e.g.*, *Schulze*, col. 7, ll. 5-8, col. 2, ll. 65-67, col. 18, ll. 34-39.

Schulze fails to disclose "analyzing the list of prospective merchants based on a set of merchant qualification criteria to form a set of merchants," "generating a list of prospective customers," "analyzing the list of prospective customers based on a set of customer qualification criteria to form a set of customers" and "generating partnership checks, wherein each of the partnership checks includes an account number

associated with a respective customer in the set of customers and a routing number," as recited in amended independent claim 18.

Accordingly, for at least the above-outlined reasons, *Schulze* fails to disclose all of the subject matter recited in Applicants' amended independent claim 18. Therefore, the rejection of independent claim 18 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claims 19-21 depend from independent claim 18. As discussed above, *Schulze* does not support a rejection of independent claim 18. Therefore, dependent claims 19-21 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claim.

II. Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Schulze*. To support this position, the Examiner takes Official Notice. *See* Office Action, p. 3. As explained below, Applicants traverse the taking of Official Notice in the Office Action and respectfully request the Examiner to provide authority to support the Examiner's position.

A general allegation that something may be "well known" is not sufficient to support a taking of Official Notice. "[T]he basis for [the examiner's] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." See *[In re Soli*, 317 F.2d 941, 137 U.S.P.Q. 797 (CCPA 1963)], 317 F.2d at 946, 37 USPQ at 801; *[In re Chevenard*, 139 F.2d 711, 60 U.S.P.Q. 239 (CCPA

1943)], 139 F.2d at 713, 60 USPQ at 241. "The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." *M.P.E.P.* § 2144.03(B).

In both the Non-Final and Final Office Actions, the Examiner rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Schulze*. Both times, to support this position, the Examiner took Official Notice. *See* Office Action, pp. 3-4. According to the Examiner, "inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention." Office Action, p. 3. However, the Office Action failed to address the other claim recitations, and further failed to provide any reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of *Schulze*. Applicants traversed the taking of Official Notice in the Response to Office Action, filed April 9, 2007, and in the Pre-Appeal Brief Request for Review filed February 1, 2008.

A general allegation that something may be "well known" is not sufficient to support a taking of Official Notice. "[T]he basis for [the examiner's] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *M.P.E.P.* § 2144.03(B) (internal citations omitted) (emphasis added). It is the Examiner's burden to present the explicit basis for taking Official Notice. "The applicant should be presented with the explicit basis on which the examiner regards

the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." *Id.* In the Final Office Action, however, the Examiner stated that "applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice . . . [and] [t]he examiner's taking of official notice is maintained." Office Action, p. 3. This conclusion is in violation of *M.P.E.P.* § 2144.03.

Applicants can only rebut the taking of Official Notice to the extent that the Examiner has provided "sound technical and scientific reasoning to support his or her conclusion of common knowledge." *M.P.E.P.* § 2144.03(B) (internal citations omitted). To reject three claims, the Examiner merely states that "inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention." Office Action, p. 3. In other words, the Examiner provided no reasoning, only stating that these items were in common use and obvious. This is improper.

Moreover, to establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Office Action must show, *inter alia*, that the applied reference teaches each and every element recited in the claims. *M.P.E.P.* § 2143. Here, by ignoring the recitations of claims 10, 11, and 17, the Office Action has failed to show how the cited art purportedly discloses the recitations of these claims. Specifically, the Office Action has failed to show how *Schulze* discloses "sending informative inserts to the set of customers with the partnership check," as recited in dependent claim 10. In addition,

the Office Action has failed to show how *Schulze* discloses "providing an economic incentive with the partnership check for customers that use the partnership check, wherein the type of economic incentive is determined based on maximizing profit for an issuer of the partnership check and the merchant," as recited in dependent claim 11. Additionally, the Office Action has failed to show how *Schulze* discloses "sending partnership checks to customer with information material," as recited in dependent claim 17. Thus, the rejection of dependent claims 10, 11, and 17 does not meet the requirements of at least *M.P.E.P.* § 2143 and 35 U.S.C. § 103(a), and is therefore legally improper.

Furthermore, as noted above, *Schulze* does not teach or suggest "analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that considers at least one factor associated with each merchant in the group of merchants" and "identifying one merchant of the group of merchants for associating with partnership checks based on the analysis," as recited in claim 1, from which claims 10 and 11 depend. Nor does *Schulze* teach or suggest "forming a value sharing relationship between the issuer and at least one merchant" and "generating partnership checks that are redeemable with the at least one merchant, each of the partnership checks including printed indicia that is indicative of a predetermined transaction amount, an account number associated with a respective customer in the set of customers, and a routing number," as recited in claim 13, from which claim 17 depends.

For at least these reasons, *Schulze* does not teach or suggest all the elements of Applicants' dependent claims 10, 11, and 17. Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a), and the allowance of claim 10, 11, and 17.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants do not automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 3, 2008

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